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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,817	01/18/2001	Itzhak Wilf	P-3000-US	5775
27130	7590	08/11/2004		
EITAN, PEARL, LATZER & COHEN ZEDEK LLP 10 ROCKEFELLER PLAZA, SUITE 1001 NEW YORK, NY 10020				
			EXAMINER BELIVEAU, SCOTT E	
			ART UNIT	PAPER NUMBER
			2614	6

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/761,817

Applicant(s)

WILF, ITZHAK

Examiner

Scott Beliveau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 21 November 2001 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered unless otherwise noted.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 110, 120, 140, 150, 161, 162, 171, 172, 173 (Figure 1); 205, 240 (Figure 2), 650 (Figure 3), 435, 450 (Figure 4). Corrected drawing sheets, or amendment to the specification to add the reference character(s) in the description, are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Specification*

3. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (ex. Page 3, Lines 21-23, and 29). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.
4. The use of the trademark “WebTV”, “Gateway 2000”, “Zenith”, “ATI Technologies Inc”, “Nogatech”, and “Philips” have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.
5. The disclosure is objected to because the term “anslysis engines” should be amended to read “analysis engines” (Page 11, Line 17). Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

6. Claim 4 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

*Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Menard et al. (WO 96/27840).

In consideration of claim 1, the Menard et al. reference discloses a “method” for “selecting a channel of interest from a plurality of communication channels which carry audio or video information”. The method comprises “extracting image or sound characteristic data from said audio or video information”, “searching for specific content of interest based on said image or sound information”, and subsequently “selecting a channel based on said content of interest” for automatic recording or tuning (Figures 3-7; Page 17, Line 31 – Page 18, Line 33).

Claim 2 is rejected wherein “said characteristic data is stored on at least one server computer” [709].

Claim 3 is rejected wherein “said selected channel is displayed on at least one client display” [28] (Page 13, Lines 20-22).

9. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Harrison (US Pat No. 5,867,205).

In consideration of claim 1, the Harrison et al. reference discloses a “method” for “selecting a channel of interest from a plurality of communication channels which carry audio or video information”. The method comprises “extracting image or sound

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characteristic data from said audio or video information” such as closed captioning information, “searching for specific content of interest based on said image or sound information”, and subsequently “selecting a channel based on said content of interest” for automatic recording or tuning (Col 2, Line 44 – Col 4, Line 22)

Claim 2 is rejected wherein “said characteristic data is stored on at least one server computer” [550] in connection with the distribution of the video over a LAN (Figure 5).

Claim 3 is rejected wherein “said selected channel is displayed on at least one client display” [105] (Figure 2).

10. Claims 1, 2, and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Sezan (US Pat No. 6,236,395).

In consideration of claim 1, the Sezan et al. reference discloses a “method” for “selecting a channel of interest from a plurality of communication channels which carry audio or video information”. The method comprises “extracting image or sound characteristic data from said audio or video information”, “searching for specific content of interest based on said image or sound information”, and subsequently “selecting a channel based on said content of interest” for automatically recording (Col 7, Line 50 – Col 10, Line 65)

Claim 2 is rejected wherein “said characteristic data is stored on at least one server computer” [550] (Col 12, Lines 17-27).

Claim 5 is rejected wherein the reference discloses a “method of tuning to a channel of interest from a plurality of channels received by a receiver device, using an Internet-enabled computing device” [16]. The method involves “creating a correspondence between broadcast channel signals received by said receiver device and channel characteristic data stored on at

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least one Internet site” (Col 12, Lines 17-27; Col 25, Line 22 – Col 26, Line 8) so as to facilitate the “searching for specific content of interest based on said channel characteristic data”. The system, as aforementioned, subsequently “selects” and “tunes said receiver device” [16] to the “channel based on said content of interest” in order as to record the appropriate information (Col 7, Line 50 – Col 10, Line 65; Col 11, Line 51 – Col 12, Line 16).

11. Claims 1 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Iki et al. (US Pat No. 6,008,802).

In consideration of claim 1, the Iki et al. reference discloses a “method” for “selecting a channel of interest from a plurality of communication channels which carry audio or video information”. The method comprises “extracting image or sound characteristic data from said audio or video information”, “searching for specific content of interest based on said image or sound information”, and subsequently “selecting a channel based on said content of interest” for automatic recording or tuning (Figure 3; Col 2, Lines 53-67; Col 4, Lines 47 – Col 5, Line 53)

Claim 5 is rejected wherein the reference discloses a “method of tuning to a channel of interest from a plurality of channels received by a receiver device, using an Internet-enabled computing device” (Figure 1). The method involves “creating a correspondence between broadcast channel signals received by said receiver device and channel characteristic data stored on at least one Internet site” in the form of an EPG (Col 6, Lines 14-21).

Subsequently, the embodiment is operable to “searching for specific content of interest based on said channel characteristic data” so as to “select” and “tune” [110] “said receiver device”

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[100] to the “channel based on said content of interest” so as to record the program (Figure 3, Col 2, Lines 53-67; Col 4, Lines 47 – Col 6, Line 51).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iki et al. (US Pat No. 6,008,802), in view of applicant's admitted prior art.

Claim 5 is rejected wherein the Iki et al. reference discloses a “method of tuning to a channel of interest from a plurality of channels received by a receiver device, using an Internet-enabled computing device” [100] (Col 4, Lines 59-65). The method involves “creating a correspondence between broadcast channel signals received by said receiver device and channel characteristic data” in the form an EPG data [312]. Subsequently, the embodiment is operable to “search for specific content of interest based on said channel characteristic data” so as to “select” and “tune” [110] “said receiver device” [100] to the “channel based on said content of interest” so as to record the program (Col 4, Lines 20-58; Col 6, Line 12 – Col 7, Line 60).

As to the limitation wherein the “channel characteristic data” is “stored on at least one Internet site”, while the reference makes reference to the usage of the Internet as a means for retrieving data, it is unclear if the EPG data necessarily is derived from an Internet based site.



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Applicant's admitted prior art discloses that it is known in the art for "channel characteristic data" or EPG data to be "stored on at least one Internet site" (Page 3, Lines 28 – Page 4, Line 2). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Iki et al. reference, if necessary, so as to utilize EPG data retrieved from the Internet for the purpose of providing an inexpensive and universally accessible means for retrieving of program guide data.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Nickum (US Pat No. 6,721,954) reference discloses a system and method for implementing a preferred viewing library of programs.
- The Greenspan et al. (WO 00/05884) reference discloses a method of selecting at a video receiver a desired video program channel from a number of program channels. This reference does not currently qualify as prior art under 35 U.S.C. 102 in light of applicant's claim to an earlier filing date.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEB  
July 27, 2004

  
JOHN MILLER  
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